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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,903	03/31/2000	CHRISTINE DUPUIS	05725.0532	7762

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EXAMINER

MITCHELL, GREGORY W

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/485,903

Applicant(s)

DUPUIS ET AL.

Examiner

Gregory W Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-26,28-32,35,36 and 40-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-26,28-32,35,36 and 40-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/2/04
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

This office action is in response to the remarks and amendments filed July 2, 2004. Claims 1-17, 27 and 37-39 have been cancelled. Claims 18-26, 28-32, 35, 36 and 40-48 are pending and are examined herein.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 2, 2004 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-26, 28-32, 35, 36 and 40-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feder et al. (USPN 5721026) in view of both Dubief et al. (USPN 6024946) and Bolich (EP 0 240 349).

The instant invention is directed to a composition comprising an aqueous dispersion comprising at least one insoluble polymer particle, an emulsion comprising

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0.05-10% non-aminated silicone alpha, omega disilanol, 15-35% propellant, and a cosmetically acceptable medium, wherein the composition is in the form of an aerosol.

Feder et al. teaches aqueous silicon/copolymer dispersions crosslinkable into an elastomeric state. An oil-in-water base emulsion comprising an α,ω -(dihydroxy)polydiorganosiloxane (a non-aminated α,ω -disilanol) stabilized with a surfactant, an aqueous latex of an organic (co)polymer having a particle size ranging from 0.01 to 0.5 μm , a crosslinking agent, a filler, and a metal curing catalyst. See Abstract. The organic monomers used for preparing the polymer or copolymer are selected from alkyl(meth)acrylates (such as butyl acrylate, methyl methacrylate, etc.), unsaturated esters of monocarboxylic acids, vinylaromatic compounds (such as styrene, 4-methylstyrene, etc.), unsaturated carboxylic acids (such as acrylic acid, etc.) and others (col. 5, line 19-col. 6, line 38). Feder et al. teaches that the dispersions disclosed therein can be useful as cosmetic compositions for the treatment of hair, especially for achieving permanent waving (col. 11, lines 6-13).

Feder et al. does not teach propellants, a hair setting lotion, a process of rinsing the hair, or a percent weight of the silicone.

Dubief et al. teaches a composition for the treatment of keratinous materials consisting essentially of an aqueous medium, at least one silicone, at least one latex consisting colloid suspension of polymer particles insoluble in said aqueous medium, and at least one suspension agent for the silicone and the latex and/or at least one thickening agent (Abstract). Specifically disclosed is a non-rinsed conditioner comprising an o/w emulsion of acrylamide/sodium 2-methyl propanesulfonate

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acrylamide copolymer, a latex of vinyl acetate/acrylic ester copolymer, and a mixture of octamethylcyclotetrasiloxane dimethiconol and dodecamethylcyclopentasiloxane (col. 8, Example 1). The silicones comprise 0.1-50% of the composition and the latex polymer particles comprise 3.1-10% of the composition (col. 7, lines 26-36). Propellants are disclosed as additives (col. 7, lines 48-53). The compositions may be used as a rinsed or non-rinsed treatment lotion for application before or after shampooing, before or after perming, before or after dyeing or bleaching or between two perming or straightening steps (col. 7, lines 57-61).

Bolich teaches an aerosol hair cosmetic aqueous composition comprising a silicone elastomer, a propellant and, optionally, a hair setting polymer dispersible in an aqueous phase (Abstract; p. 2, lines 40-50; p. 3, lines 18-39). It is taught that the propellant generally makes up 3-30% w/w of the composition (preferably about 5-15% w/w), and that it may be propane, *n*-butane, dimethylether, etc. (p. 3, lines 3-16).

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the percent weight teachings of Dubief et al. into the invention of Feder et al. because (1) Dubief et al. teaches ranges of silicone and polymer particle weight percentages that either encompass or overlap with the percentages of the claims of the instant invention; and (2) it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

One of ordinary skill in the art would have been motivated to prepare a composition of Feder et al. with the weight percentages of Dubief et al. because of an

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expectation of success in preparing a hair cosmetic capable of the treatment of hair because (1) Feder et al. and Dubief et al. are both drawn to compositions comprising similar components (such as an aqueous component, a silicone component, a polymer particle component, etc.); (2) both Feder et al. and Dubief et al. teach that the compositions therein are useful for treating hair; and (3) Feder et al. teaches a hair cosmetic but does not specifically disclose the weight percentages of the components therein so as to be useful in the hair cosmetic. Therefore, one of ordinary skill in the art would have been motivated to look to a teaching of analogous art, such as Dubief et al., to find the weight percentages of the components taught in the Feder et al. hair treatment composition in order to obtain a formulation suitable therefor.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a propellant into the composition of Feder et al. because, (1) as taught above, Dubief et al. teaches compositions of analogous formulation and purpose as Feder et al.; and (2) Dubief et al. teaches that propellants may be used as additives therein. Furthermore, it would have been obvious to one of ordinary skill in the art to utilize the specific weight percentages of the specific propellants as claimed in the instant invention because it is taught by Bolich that aqueous hair cosmetics comprising a silicone elastomer and a hair setting polymer may be aerosolized and contain a propellant, preferably 5-15%. Accordingly, Bolich teaches an analogous art comprising a range of propellant within the range of propellant claimed within the instant application. One would have been motivated to add a propellant in the weight

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percentage of the instant application to the composition of Feder et al. because, as taught by Bolich, such preparations are useful as hair styling mousses (p. 2, lines 1-3).

Furthermore, it would have been obvious to one of ordinary skill in the art to include either (1) a latex polymer comprising the monomer styrene, because, as taught by Feder et al., styrene polymers are useful therein; or (2) a latex copolymer comprising the monomers methyl methacrylate, acrylic acid, and butyl acrylate because, as taught by Feder et al., copolymers comprising such monomers are useful therein.

It is noted that the claims of the instant application are directed to a composition comprising an aqueous dispersion comprising at least one insoluble polymer particle, an emulsion comprising 0.05-10% non-aminated silicone α,ω -disilanol, 15-35% propellant, and a cosmetically acceptable medium, wherein the composition is in the form of an aerosol. Any properties exhibited by or benefits provided by the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure or composition, the properties Applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not possess the same properties of the instant claimed product. The prior art teaches applicant to keratinous substances, such as hair, of compositions containing the same components as instantly claimed, which would necessarily possess the property of being a hair-setting lotion, as instantly claimed. Applicant has not provided

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any evidence of record to show that the prior art composition does not exhibit the same properties as those instantly claimed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-26, 28-32, 35, 36 and 40-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 35-44 of U.S. Patent No. 6,165,446 ("446").

'446 claims a cosmetic composition comprising an aqueous dispersion of insoluble polymer particles and at least one insoluble silicone. It also specifically claims the insoluble polymer where: it comprises 15-35% of the composition by weight; is a polymer or copolymer comprising styrene, butadiene, ethylene, propylene, etc.; and/or is a copolymer comprising alkyl acrylate (e.g. methyl acrylate, ethyl acrylate, propyl acrylate, and butyl acrylate), alkyl methacrylate (e.g. methyl methacrylate, ethyl methacrylate, propyl methacrylate and butyl methacrylate), and an ethylenic carboxylic

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acid (e.g. acrylic acid, methacrylic acid, crotonic acid, itaconic acid, and salts thereof).

The silicone is specifically claimed in concentrations of 0.1-3% by weight (claim 35). An aerosol composition is also specifically claimed wherein the propellant is in a concentration of 15-35% (claim 40) and is one or more of nitrous oxide, dimethyl ether, nitrogen, *n*-butane, propane, etc. (claims 36 and 37). A process of treating a keratinous substance with said composition is also claimed (claim 42). Furthermore, a composition to be used as a hair setting lotion, a lotion for blow-drying, a fixing composition, or a styling composition is claimed (claim 31).

'446 does not specifically claim an α,ω -disilanol but an α,ω -disilanol is encompassed by the claimed "silicone" composition. It would have been obvious to one of ordinary skill in the art to use an α,ω -disilanol composition in the invention claimed in '446 because α,ω -disilanol is a silicone.

Response to Arguments

Applicant's arguments with respect to claims 18-48 have been considered but are moot in view of the new ground(s) of rejection. Examiner addresses Applicant's arguments as applied to the new rejection as follows:

Applicant argues that "the Office still has not pointed to any evidence in the references demonstrating a motivation or desirability to modify the composition of Feder to include the recited amount of the at least one non-aminated silicon α,ω -disilanol."

This argument is not persuasive. Examiner has provided such motivation in the instant rejection, as described above. Examiner does not rely solely on the holding of *In re*

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Aller, but also points out that because Feder et al. teaches a cosmetic for the treatment of hair but does not disclose the precise weight percentages to be used therein, one would have been motivated to look at a reference of analogous art in order to determine the appropriate weight percentages. Examiner has shown that Dubief et al. is such an analogous art.

Applicant argues that Feder only “generally mentions the possibility of using its aqueous silicone dispersions in cosmetic compositions, [while] most of the disclosure in Feder is directed to non-cosmetic uses such as paint, silicon elastomer seals, water-repellant coatings for structural surfaces, coating pharmaceuticals or plant-protective active substances.” Applicant further argues that “[I]t is in a laundry list of applications that Feder mentions that the aqueous dispersion may also be used in ‘cosmetic compositions for the treatment of hair’.” These arguments are not persuasive. Feder et al. does not simply list the treatment of hair in a “laundry list” of possible uses of the compositions described therein; Feder et al. provides *specific* motivation for the use of such compositions in both hair cosmetics and facial cosmetics. For example, Feder et al. specifically states that such “dispersions can be incorporated into cosmetic compositions for the treatment of hair, especially for permanent waving with a view to creating a porous elastomeric film on the strands of hair.” Furthermore, it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to a person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); *In re Lamberti*, 545

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F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); *In re Kaslow*, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983).

Applicant also argues that “[I]n Example 1, Table 1, Feder shows the preparation of an emulsion and the testing of adhesiveness of that emulsion to glass and concrete surfaces ... Nowhere in this example is it suggested to use this particular emulsion for the treatment of hair. Furthermore, the analyzed mechanical properties and the assessment of adhesion, using a 4 mm thick bead, to glass and concrete teaches away from a cosmetically acceptable composition for this particular combination.” This argument is not persuasive. Examiner points out that while not specifically teaching the composition of Example 1 for hair cosmetic use, Feder et al. does state that “[t]he dispersions according to the invention can also be employed in cosmetology ...” Furthermore, Examiner does not agree with Applicant’s interpretation of the teachings of Example 1. First, Applicant has provided no evidence to show that the mechanical properties of Example 1 are undesirable in hair cosmetics. Second, it is Examiner’s position that the mechanical properties provided in Example 1 are consistent with the specific motivation provided by Feder et al. for preparing a hair cosmetic. Feder et al. states that the hair cosmetic is to create a “porous elastomeric film on the strands of hair.” Example 1 teaches an elastomer with good adhesive properties. First, the hair cosmetic taught by Feder et al. is explicitly stated to form an “elastomeric film on the strands of hair.” Second, it is Examiner’s position that in order for the elastomeric to (1)

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viably form a film on the hair and (2) be aesthetically acceptable, it would be necessary for the film to adhere to the strands of hair.

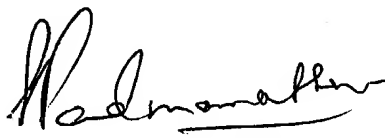
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8 AM - 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm


SREENI PADMANABHAN
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